Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROBERT CARL VEAL

Appeal No. 2003-0388
Application No. 09/499,124

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 7, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to the field of boat trailers. More specifically, the invention comprises a skid assembly which may be attached to the frame of a boat trailer just forward of the wheels to prevent the boat trailer wheel from dropping abruptly off the end of a ramp, thereby causing the trailer to become stuck (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Herndon	3,933,372	Jan. 20, 1976
Des Roches	5,195,767	Mar. 23, 1993
Eggleston	5,806,871	Sep. 15, 1998

Claims 1 to 4, 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eggleston in view of Des Roches.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Eggleston in view of Des Roches and Herndon.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final

rejection (Paper No. 4, mailed April 26, 2001) and the answer (Paper No. 11, mailed August 7, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 10, filed April 29, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 7 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention.

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the rejections under 35 U.S.C. § 103 before us in this appeal (final reejction, pp. 2-6), the examiner (1) set forth the teachings of the applied prior art (i.e., Eggleston, Des Roches and Herndon); (2) ascertained the differences between the claimed subject matter and Eggleston;[1] and (3) with respect to the independent claims on appeal (i.e., claims 1 and 6) concluded that it would have been obvious to one skilled in the art "to modify the device of Eggleston to include a means for adjusting and fixing the vertical distance between the front part of the skid plate and the frame as taught by Des Roches."

The appellant (brief, pp. 5-7) argues that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require at least a first skid plate to be attached to the trailer frame so that (1) the vertical separation between the forward portion of the first skid plate and the trailer frame can be adjusted and fixed, and (2) the vertical separation

[1] After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

between the rearward portion of the first skid plate and the trailer frame can be adjusted and fixed. However, these limitations are not suggested by the applied prior art. In that regard, while Eggleston does teach a first skid plate attached to the trailer frame so that the vertical separation between the rearward portion of the first skid plate and the trailer frame can be adjusted and fixed, Eggleston does not teach or suggest making the vertical separation between the forward portion of the first skid plate and the trailer frame adjustable. To supply this omission in the teachings of Eggleston, the examiner relied on the teachings of Des Roches to render that difference obvious to an artisan. However, Des Roches is directed not to an adjustable skid plate on a boat trailer but to adjustable guide rails on a boat trailer to assist in unloading a boat from the trailer into the water and loading a boat from the water onto the trailer. In our view, the only suggestion for modifying Eggleston in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure, not the teachings of the applied prior art.[2] The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 to 7.

[2] We have also reviewed the Herndon reference additionally applied in the rejection of claim 5 but find nothing therein which makes up for the deficiencies of Eggleston and Des Roches discussed above.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 7 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT Administrative Patent Judge	)
LAWRENCE J. STAAB Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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